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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,241	12/18/2001	Uwe Heinelt	02481.1763-00	8753

7590

04/23/2003

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EXAMINER

RAO, DEEPAK R

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 04/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/020,241

Applicant(s)
Heinelt et al.

Examiner
Deepak Rao

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 18, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 ☒ are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Claims 1-34 are pending in this application.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

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- I. ~~Claims 1-5 and 33-34, drawn to compounds of formula I or Ia and corresponding~~
composition, classified in class 544/546/548, various subclasses depending on the
Het ring.
- II. Claim 6, drawn to a process of preparation of compound of formula I or Ia,
classified in various class/subclasses.
- III. Claims 7-8, drawn to another process of preparation of compound of formula I or
Ia, classified in various class/subclasses.
- IV. Claim 9-11, drawn to another process of preparation of compound of formula I or
Ia, classified in various class/subclasses.
- V. Claim 12, drawn to another process of preparation of compound of formula I or Ia,
classified in various class/subclasses.
- VI. Claims 13-15, drawn to another process of preparation of compound of formula I
or Ia, classified in various class/subclasses.
- VII. Claim 16, drawn to another process of preparation of compound of formula I or Ia,
classified in various class/subclasses.

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- VIII. Claims 17-20, drawn to a method of use of compound of formula I or Ia, classified in various class 514 and various subclasses.
- IX. Claims 21-24, drawn to another method of use of compound of formula I or Ia, classified in various class 514 and various subclasses.
- X. Claims 25-27, drawn to another method of use of compound of formula I or Ia, classified in various class 514 and various subclasses.
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- XI. Claims 28-29, drawn to another method of use of compound of formula I or Ia, classified in various class 514 and various subclasses.
- XII. Claim 30, drawn to another method of use of compound of formula I or Ia, classified in various class 514 and various subclasses.
- XIII. Claim 31, drawn to another method of use of compound of formula I or Ia, classified in various class 514 and various subclasses.
- XIV. Claim 32, drawn to another method of use of compound of formula I or Ia, classified in various class 514 and various subclasses.

The inventions are distinct, each from the other because of the following reasons:

Inventions II-VII and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the

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instant case the product as claimed can be made by different processes using materially different intermediates and/or reagents.

Inventions I and VIII-XIV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. (MPEP

§ 806.05(h)). In the instant case the different processes of use can be practiced by other known therapeutic agents. Also, the product can be used in different processes involving different functions and/or effects.

Inventions II-VII and VIII-XIV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the inventions have different modes of operation, i.e., some are drawn to synthetic processes and the others are therapeutic methods.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Claims 1-34 are generic to a plurality of disclosed patentably distinct species comprising the species embraced by the generic structural formulae. In addition to election of a single group

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from above, applicant is required under 35 U.S.C. 121 to **elect a single disclosed species that falls within the elected group**, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission _____ may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

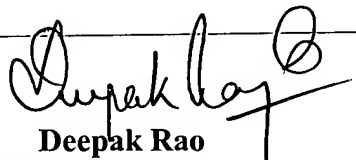
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (703) 308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Deepak Rao
Primary Examiner
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April 21, 2003